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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,967	10/19/2001	Hiromu Ueshima	100341-00017	7298

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,967	UESHIMA ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2005* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

♦

In response to the communication filed May 4th, 2005.

This action is Final.

Claims 10-22 are rejected.

♦

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim **10** is rejected under 35 U.S.C. 102(e) as being anticipated by Ng (6,328,570).

[The section entitle Response to Arguments below is incorporated herein]

Ng teaches a portable karaoke unit including a removable memory cartridge, means for selecting a karaoke program from a plurality of karaoke programs store on the removable memory cartridge. Ng further teaches the inclusion of a cartridge sensing means and the utilization of identifiers to enable/disable cartridge content use.

Specifically Ng utilizes removable memory cartridge (135) capable of storing games programs and song related data including audio data, lyrics, timing information and graphical information (Col 3:37-44). Ng teaches the use of a menu system interface for directing the desired functionality of the unit (Fig 1, 5, 10 & Col 3:24-34 & Col 5:7-9). This menu interface description has been interpreted as the means of selecting the karaoke program and the means of selecting the game program from a plurality of similar stored programs.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **11-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (6,328,570).

[The section entitle Response to Arguments below is incorporated herein]

Ng teaches a portable karaoke unit including a removable memory cartridge, means for selecting a karaoke program from a plurality of karaoke programs store on the removable memory cartridge. Ng further teaches the inclusion of a cartridge sensing means and the utilization of identifiers to enable/disable cartridge content use.

Specifically Ng utilizes removable memory cartridge (135) capable of storing games programs and song related data including audio data, lyrics, timing information and graphical information (Col 3:37-44). Ng teaches the use of a menu system interface for directing the desired functionality of the unit (Fig 1, 5, 10 & Col 3:24-34). This menu interface description has been interpreted as the means of selecting the karaoke program and the means of selecting the game program from a plurality of similar stored programs.

Ng teaches the determination of whether or not a cartridge is legal (620). An illegal cartridge is provided for as "the cartridge **135** is not a compatible cartridge, the identification information stored on the cartridge **135** is invalid... If it is not legal, then in step **630**, karaoke unit **100** displays information about the illegal operation and the routine ends" (Col 7:28-33).

Form the preceding the following is understood.

I. Ng utilizes identifiers (held as equivalent to identification information) in order to determine compatibility.

II. In order to determine (determination) whether or not an identifier is appropriate (legal) the base must perform a comparison or analysis of the identifier stored. This is resultant from the fact that the only processor shown (210) is located in the body of the device.

III. Based on this determination an operation is either allowed to proceed or terminated.

IV. The displaying of illegal information is considered equivalent to the displaying of a "warning message" and equivalent presented language.

In view of the preceding points it is understood that the invention of Ng would only allow the use of programs with corresponding identifiers to the based and that the detection of cartridge presence would be implicitly required for the analysis of information/programs contained on said cartridge. Ng however does not explicitly state that each program has a corresponding assigned identifier or that an identifier is stored in the base rather then the cartridge. It would have been obvious to one of ordinary skill in the art to store an identifier in the base in order to allow the processing unit of the base to determine the correspondence between the intended media and the present media device to insure compatibility. It would have been obvious to one of ordinary skill in the art at the time of invention to associate the identifier with the programs of Ng

rather then the memory cartridge to allow reuse of the memory cartridge with multiple media playing devices.

Response to Arguments

Applicant's arguments filed 5/04/2005 have been fully considered but they are not persuasive.

I) Applicant argues the following claim language:

"determining whether the memory cartridge is attached to a main body of the karaoke apparatus or to the main body of the gaming apparatus"

as providing a selective detection means wherein the claimed system/method determines which of the two presented optional devices (Karaoke/Gaming)the cartridge is attached to (*Applicant's Remarks Pages 2,3, & 4*).

This point fails as the applicant has provided an interpretation of the claim language of a *narrower scope* then the presented claim language. In particular the above cited clause also reads as an alternative statement wherein the claimed system/method provides a selective detection means wherein the claimed system/method determines if either one of the two presented optional devices (Karaoke/Gaming) the cartridge is attached to. In the art of Ng as applied Particular device is a karaoke device as correlated in the rejection previous presented and

maintained above. It is further noted that the presented claim language provides no preclusion to the use of a common Karaoke/Gaming interface

II) Applicant argues, "Ng fails to disclose that it is possible to simultaneously store a plurality of programs in a single cartridge" (*Applicant's Remarks Pages 3 & 5*).

With reference to the pending claims the applicant supports the argued feature with "at least one karaoke program and at least one game program" (Claims 10 & 20). Ng however is still understood for providing this feature with "This allows users to purchase cartridges with song, programs, and/or graphics for use in their karaoke unit" (Col 5:1-3). Hence Ng demonstrates the ability of the cartridge to store a variety of data including a plurality of programs in a single cartridge. In view of the preceding the rejection is maintained.

III) Applicant argues, that Ng teaches the use of a menu system for the determination of which program from a plurality of programs is executed in contrast to the claimed invention which utilizes a selection process dependent on the type of body the cartridge is inserted in (*Applicant's Remarks Pages 3 & 5*).

This point fails as the applicant has provided an interpretation of the claim language of a *narrower scope* then the presented claim language. The presented claim language while providing for the selection of a respective program type dependent on the game body which it is joined, does not preclude a karaoke program of a game operable on a karaoke device and moreover fails to isolate the selection process to an

automated act of the system juxtapose to the result of a user input. In view of the preceding the rejection is maintained.

IV) Applicant argues, that Ng fails to teach that the cartridge is insertable into a plurality of main bodies (*Applicant's Remarks Pages 3 & 5*).

This point fails as the applicant has provided an interpretation of the claim language of a *narrower scope* then the presented claim language. First as stated in Section I above the presented claim language reads on an alternative arrangement rather then the inclusive selection and as such may only define a singular type device. In view of the preceding the rejection is maintained.

V) Applicant's conclusion statements like wise fall for their reliance on the above points addressed above(*Applicant's Remarks Pages 3 & 5*). Applicant's claim citation regarding the inclusion of at least one game program and at least one Karaoke program is addressed in section II above in addition to patented claim number 2 of NG. In view of the preceding the rejection is maintained.

VI) Applicant argues the equation of a Ng's determination of a legal cartridge is improperly correlated to the claimed warning signal message program based the absence of a cartridge (*Applicant's Remarks Pages 5-8*).

First, to expedite the reduction of this issue, please note the following hypothetical amendment of claim 18.

".. if a legal memory cartridge is not attached to the main body of the karaoke apparatus, selecting a warning message program stored in the main body of the karaoke apparatus."

The proposed language is viewed as a more precise correlation to the Ng reference and provided to draw light to the issue at hand. In particular the specific example though setting forth the particular embodiment of Ng's illegal message would be encompassed by the applicant's current broader claim language of a "warning message". Likewise the rejection is maintained as the prior art teaches a specific subset of cartridge validation while the applicant has claimed the broader concept.

Second it is noted that the detection of the cartridge absence results in the execution of a program however there are no defined results that might isolate the claimed warning program from the prior art. In particular if one attempted to access a non-connected cartridge in the device of Ng, the user interaction with the menus of Ng (a program) would still execute and hence could readily be correlated to that of the claimed warning program. This point is furthered as no set limitations of the claim precludes the execution of a "warning program" when the cartridge is attached.

Remaining issues are believed to fall with the above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

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SUPERVISORY PATENT EXAMINER
TC3700